

REMARKS

Claims 1–20 are pending in the present application.

Claims 10–20 were added.

Reconsideration of the claims is respectfully requested.

35 U.S.C. § 103 (Obviousness)

Claims 1–9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. D181,058 to *Kaye*. Claims 1–9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. D266,045 to *Kamel et al.* Claims 1–9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. D139,954 to *Krass*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-123 (8th ed. rev. 1 February 2003). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.*

To establish a *prima facie* case of obviousness, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or

suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142 at p. 2100-124.

Independent claim 1 recites a placemat body including a major portion sized to completely underlie a place setting including a plate and silverware and a coaster extension projecting from a peripheral edge of the major portion and sized to completely underlie a beverage container. The claim thus requires an identifiable coaster portion having a size sufficient to at least underlie a beverage container. Such a feature is not found in *Kaye*. *Kaye* simply discloses a placemat shaped like a cat and kittens.

As conceded in the Office Action, *Kaye* does not reveal the size of the body of the cat versus the head. Moreover, the statement concerning obviousness of size within the Office Action is not an accurate statement of the current law. Obviousness inquiries, due to their highly fact-specific and fact-intensive nature, have been deemed not to be amenable to *per se* rules such as that expressed in the Office Action. *In re Ochiai*, 71 F.3d 1565, 1569 (Fed. Cir. 1995). Mere citation of a *per se* rule regarding what constitutes obvious modifications, without identifying a motivation or incentive for the proposed modification, does not establish a *prima facie* case of obviousness. Accordingly, hindsight reconstruction of the claimed invention based on “desired protection coverage” does not establish motivation for the employed relative dimensions recited in the claims. Moreover, use of the teachings of the application (“since beverage containers may be sized up to about 3-4 inches as stated in the instant specification”) in hindsight reconstruction of the claimed invention is improper.

Furthermore, it is well-established that measurement of patent drawings may not be relied upon to determine if dimensional claim limitations are distinguishable. *In re Wilson*, 312 F.2d 449, 454, 136 U.S.P.Q. 188, 192 (CCPA 1963) ("Patent drawings are not working drawings . . ."); *In re Reynolds*, 443 F.2d 384, 389, 170 U.S.P.Q. 94, 98 (CCPA 1971) ("[A] patent drawing does not have to be to any particular scale."); *In re Chitayat*, 408, F.2d 475, 478, 161 U.S.P.Q. 224, 226 (CCPA 1969) ("In view of the absence in [the] specification of any written description of any quantitative value . . ., arguments based on mere measurement of the drawings appear to us to be of little value"). A patent drawing does not define the precise proportions of the elements depicted and thus may not be relied on to show particular distances or sizes when the specification is completely silent in that respect. *In re Heinle*, 342 F.2d 1001, 1007, 145 U.S.P.Q. 131, 136 (CCPA 1965). Accordingly, there is no basis for concluding that the dimensional limitations of the claims are satisfied by the subject matter disclosed in *Kaye*.

Kamel does not disclose a placemat-coaster design, just a placemat specifically providing places for a plate, bread, butter, and silver, but does specify a coaster or beverage container placement. The fact that a suitably-sized beverage container might happen to fit on one of the butter, bread or silver extensions does not establish anticipation of the claim. As described above, the recitation of *per se* obviousness and use of applicants teachings for hindsight reconstruction of the claimed invention is improper.

Krass discloses a tray, not a placemat. Contrary to the assertion in the Office Action, trays and placemats are structurally distinguishable.

The present invention provides a placemat-coaster design that may be employed to eat, with a plate and utensils placed on the placemat portion and a drink container on the coaster portion. When viewing the design, the placemat portion and the coaster portion can be easily identified, although both the placemat and the coaster are tied by a common theme. The placemat-coaster has a theme, examples of which include:

Placemat:	Monitor
Coaster:	Mouse
Theme:	Computers

Placemat:	Earth
Coaster:	Moon
Theme:	Space

Placemat:	Dollar Bill
Coaster:	Coin
Theme:	Money

Placemat:	Heart
Coaster:	Tip of Arrow
Theme:	Love

The placemats and coasters of the present invention are joined together, but more importantly are linked by a common theme. However, upon viewing the portion to be used for a placemat and the portion to be used as a coaster are apparent. Therefore, although physically and thematically tied, the placemat and coaster are distinct items.

Therefore, the rejection of claims 1–9 under 35 U.S.C. § 103 has been overcome.

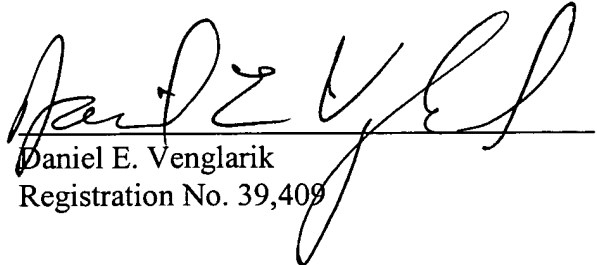
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 12-9-03


Daniel E. Venglarik
Registration No. 39,409

P.O. Box 802432
Dallas, Texas 75380
(972) 628-3621 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *dvenglarik@davismunck.com*